

REMARKS

A. Regarding the Amendments

Claims 32-74 are pending. Claims 32, 40, 41, 43, 51, 54, 58, 63, 67, and 72 have been amended to claim the subject matter of the invention with greater particularity and specificity. Amendments to claims merely clarify the language of claims and specification.

Specifically, claim 32 now recites a device which is a "single unit." The limitation "single unit" is disclosed throughout the original specification. See, e.g., abstract, FIGs. 2-4, and page 9, lines 18-28.

Accordingly, it is respectfully submitted that no new matter has been introduced by the amendments.

B. Claim Objections

The Applicant has noted and acknowledged the fact that the Examiner has withdrawn the objections to claim (page 2, first paragraph of the Office Action).

C. Rejection Under 35 U.S.C. § 102 (b)

Claims 32-36, 38-39, 42-47, 49-50, 53-57, 62-66 and 71-74 have been rejected under 35 U.S. C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,339,000 to Bashan et al. This rejection is respectfully traversed.

It is undisputable that a valid rejection of a claim for anticipation by a reference requires that the reference explicitly or inherently describe all of the elements, limitations, and relationships recited in the claim. It is submitted that Bashan et al. do not describe all the elements and limitations recited in each of claims 32, 43, 54, 63, and 72, as amended. Each of these claims recites a device including "a single hand-held unit" containing "monetary receiving means." In addition, each of claims 32 and 63 also recites all of the following elements: input means, communication means, storage means, timing means, processor means, signal generation

means, and display means, and each of claims 43 and 54 recites the same elements as claims 32 and 63, except storage means.

Bashan et al. fails to disclose a device **having only a single unit** which integrates all the elements recited in claims 32, 43, 54, 63, and 72. Indeed, in Basham et al., there are **two units**, not one. The first unit in Bashan et al. is a "parking tag 11" which is not a hand-held device, but rather a device that is attached to an inside surface of a car window (see, Col. 7, lines 26-27). It is this unit that is designed for accepting the payment (see, Col. 7, lines 36-37). The second unit in Bashan et al. is a reading device 12 which accepts a signal from the parking tag 11 and deducts the payment accordingly (See, Col. 7, lines 60-62, and Col. 8, lines 13-15). It is very clear that Bashan et al. requires the presence of both units; otherwise, the device disclosed by Bashan et al. would be inoperable.

To summarize, Bashan et al. disclose neither a one unit-device nor the presence of the monetary accepting means in the hand-held portion of the device, as required by the instant claims 32, 43, 54, 63, and 72. In view of the foregoing, each of claims 32, 43, 54, 63, and 72 is patentably distinguishable over Bashan et al.

Each of claims 33-36, 38, 39, and 42 directly or indirectly depends on claim 32 and is considered patentable for at least the same reason.

Each of claims 44-47, 49, 50, and 53 directly or indirectly depends on claim 43 and is considered patentable for at least the same reason.

Each of claims 55-57, 61, and 62 directly or indirectly depends on claim 54 and is considered patentable for at least the same reason.

Each of claims 64-66, 70, and 71 directly or indirectly depends on claim 63 and is considered patentable for at least the same reason.

Each of claims 73 and 74 depends on claim 72 and is considered patentable for at least the same reason.

Accordingly, withdrawal of the rejection of claims 32-36, 38-39, 42-47, 49-50, 53-57, 62-66 and 71-74 and reconsideration are respectfully requested.

D. Rejections Under 35 U.S.C. § 103 (a)

Claims 37 and 48 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bashan et al. in view of Hjelmvik (WO 98/30982). In addition, claims 40-41 and 51-52 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bashan et al. in view of US Patent No. 5,166,680 to Ganot. In addition, claims 58-60 and 67-69 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bashan et al. in view of Vazvan (WO 97/19568). Finally, claims 61 and 70 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bashan et al. in view of Vazvan and further in view of Official Notice. These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, the following three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference(s) as proposed by the Examiner; (2) there must be a reasonable expectation of success and (3) the prior art reference(s) must teach or suggest all of the claim limitations. The Applicant respectfully submits that none of the criteria has been satisfied in this case. As discussed above, Bashan et al. do not disclose or suggest every limitation of claims 32, 43, 54, 63, and 72, and the combination of Bashan et al. with either Hjelmvik, Ganot, Vazvan, or Official Notice fails to cure this deficiency.

Specifically, Hjelmvik shows a hand-held parking control unit which includes a display, a computer unit with memory and a communication unit (see, page 6, lines 29-31). Hjelmvik does not disclose a portable unit having "monetary accepting means." In other words, Hjelmvik does not disclose a portable unit designed for accepting payments. Hjelmvik is concerned solely with parking control and enforcement, not with money collections. Indeed, Hjelmvik does not motivate one skilled in the art to modify the device to make it suitable for transacting any payments, since "printing parking fine tickets" is an "especially preferred embodiment" (see,

page 9, lines 20-22). Accordingly, it can be concluded that the disclosures of Bashan et al. and Hjelmvik cannot be properly combined.

Ganat describes a parking meter device comprising a "smart card" and a register (see, abstract; FIG. 1, and Col. 4, lines 39-42). A password can be used to prevent unauthorized use (see, Col. 9, lines 10-12). Ganat concerned solely with facilitation of collection and processing of payment. The device described by Ganat is merely an advanced electronic parking meter, not concerned with registering, controlling or verifying the identity of a vehicle. The disclosure of Ganat provides no information indicating that having two separate units being in radio communication is desirable, as required by the technology employed by Bashan et al. Therefore, one skilled in the art would not be motivated to combine the disclosures of Bashan et al. and Ganat.

Vazvan describes hand-held devices such as mobile telephones that can be useful in organizing parking (see, page 2, lines 9-22). Vazvan does not disclose a portable unit having "monetary accepting means." In other words, the devices described by Vazvan are designed for gathering the information regarding parking. Vazvan's devices are not designed for accepting money. For the money collection purposes, Vazvan teaches that the customer is billed by his telephone service provider (see, page 4, lines 35-36 through page 5, lines 1-2).

Thus, the money collections means provided by Vazvan are so different from those provided by Bashan et al. that it would be reasonable to conclude that there is no suggestion or motivation in either Bashan et al. or in Vazvan to combine the two disclosures. With regard to the Official Notice, just the definition of the Internet is additionally provided. Therefore, the Official Notice provides no additional suggestion or motivation for combining Bashan et al. with Vazvan et al.

In view of the foregoing, it is respectfully submitted that each of claims 32, 43, 54, and 63 is distinguishable over the references cited by the Examiner. Each of claims 37, 40 and 41 directly or indirectly depends on claim 32 and is considered patentable for at least the same reason. Each of claims 48, 51 and 52 directly or indirectly depends on claim 43 and is considered

In re Application of:

Leslie John Cass

Application No.: 09/830,018

Filed: October 21, 1999

Page 15

PATENT

Attorney Docket No.: ADAMS1100

patentable for at least the same reason. Each of claims 58-60 and 61 directly or indirectly depends on claim 54 and is considered patentable for at least the same reason. Each of claims 67-69 and 70 directly or indirectly depends on claim 63, and is considered patentable for at least the same reason. Reconsideration and withdrawal of the rejection are respectfully requested.

In re Application of:
Leslie John Cass
Application No.: 09/830,018
Filed: October 21, 1999
Page 16

PATENT
Attorney Docket No.: ADAMS1100

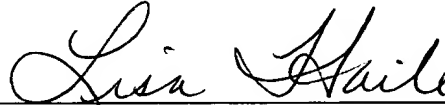
CONCLUSION

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved, the Examiner is requested to contact the undersigned at the telephone number given below so that a prompt disposition of this application can be achieved.

Enclosed is Check No. 576930 in the total amount of \$905.00 as payment for the Three Month Extension of Time fee (\$510.00) and Request for Continued Examination fee (\$395.00). If any additional fee is required, the Commissioner is hereby authorized to charge the amount of this fee, or credit any overpayments, to Deposit Account No. 07-1896.

Respectfully submitted,

Date: April 1, 2005



Lisa A. Haile, J.D., Ph.D.
Registration No. 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

DLA PIPER RUDNICK GRAY CARY US LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133
USPTO Customer Number 28213